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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
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		Filed <u>November 28, 2000</u>	
		First Named Inventor <u>Focke, N.</u>	
		Art Unit <u>3721</u>	
		Examiner <u>Tawfik</u>	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/95)</p> <p><input type="checkbox"/> attorney or agent of record. Registration number <u>                    </u></p> <p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 <u>29,526</u></p>		<p><u>Todd Deveau</u> Signature <u>Todd Deveau</u> Typed or printed name <u>(770) 933-9500</u> Telephone number <u>May 18, 2006</u> Date</p>	
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p>			
<p><input type="checkbox"/> Total of <u>          </u> forms are submitted.</p>			

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**MAY 18 2006**

## Patent

Docket No. 820601-1020

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**In re application of:**

FOCKE, Heinz et al.

**Serial No.: 09/724,016**

**Filed: 28 November 2000**

For: **PROCESS FOR PRODUCING  
HINGE-LID BOXES FOR CIGARETTES**

Group Art Unit: 3721

**Examiner: Tawfik, S.**

Confirmation No.: 7235

**REMARKS IN SUPPORT OF**  
**PRE-APPEAL BRIEF CONFERENCE**

**Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450**

Sir:

Applicant submits the following remarks in support of its Request for a Pre-Appeal Brief Conference.

**REMARKS**

This is an appeal from the Final Office Action mailed January 18, 2006, Paper No. 01122006, as clarified by Advisory Actions mailed March 31, 2006 and April 27, 2006. Claims 48-54 are pending. Claims 45-47 and 52-54 are allowed. Claims 48-51 are finally rejected. Claim 48 is an independent claim, and claims 49-51 depend upon claim 48.

Applicant submits there are clear errors in the final rejection of claims 48-51 and the basis of the rejection is insufficient to provide a prima facie rejection of claims 48-51. Claim 48 recites:

A process for folding and sealing an outer wrapper on a dimensionally stable pack comprising the following steps:

- providing a shrink wrapping film for forming the outer wrapper;
- wrapping the shrink wrapping film around the pack to form side tabs, bottom tabs, and top tabs;
- causing the side tabs to overlap one another;
- thermally pre-sealing the side tabs;
- causing the bottom tabs to overlap one another and the top tabs to overlap one another;
- thermally pre-sealing the overlapping bottom and top tabs; and
- subsequently
- permanently sealing the side tabs; and
- permanently sealing the bottom and top tabs.

The Final Office Action mailed January 18, 2006 rejects independent Claim 48, referring to Figs. 1, 3 and 4 of Neri (U.S. 5,701,725) as the basis of the rejection. More particularly, the Office Action comments that Neri discloses pre-sealing the side tabs via laser beam 53, thermally pre-sealing the bottom and top tabs via laser beam 62 and "subsequent permanently sealing the side tabs; and permanently sealing the bottom and top tabs (Figs. 1, 3, and 4; via the compressing means holding to the pack even after the laser beam seals the packs, that could consider as permanently seal)". Applicant noted in its Response and Amendment filed 20 March 2006 that the Office Action fails to identify the cited "compressing means" and that no reference numerals

were provided to identify the “compressing means” referred to in Neri that are alleged to permanently seal the side tabs recited in claim 48, and also that Neri fails to teach or suggest the order of the steps of claim 48.

The Advisory Action mailed March 31, 2006 states that claim 48 is not in condition for allowance “because: the Examiner maintains that ‘725 discloses the limitations of claim 48; as considering the laser beams causing the pre-sealing of the side tabs, bottom and top tabs and the pocket 43 to finish the seal (Column 3, lines 60-63); as walls 44 contacting the tabs could be considered as permanently sealing side tabs, bottom, and top tabs. Alternatively, broadly considering the claimed permanently sealing could be considered as of stacking the backs, somehow they will be compressing each other by the sides, top, and bottom. So the stacking step could be considered as a step of permanently sealing side, bottom, and top tabs.” (Emphasis added).

The clarification presented in the Advisory Action, and also in the subsequent Advisory Action, however, does not support the rejection of claim 48. The rejection relies upon Column 3, lines 59-63, of Neri to support the rejection of claim 48. Neri at Column 3, lines 59-63 states: “Station 37 comprises an unloading device 42 in turn comprising a substantially U-shape pocket which presents two lateral walls 44 on either side of path P and for cooperating with and compressing portions 24 onto respective portions 25.”

The relied upon citation in Neri fails to teach or suggest that walls 44 provide the function of “permanently sealing” one tab to another tab of wrapping 34, as recited in claim 48. This citation, therefore, fails to meet the features of claim 48 reciting “permanently sealing the tabs” for which it is cited. Moreover, this citation to Neri makes no mention of, or reference to, the side tabs of the wrapping 34. Applicant notes that the side tabs of Neri are identified as tabs 22 and 23. There is no mention or suggestion in Neri that walls 44 serve to compress Neri’s side tabs 22 and 23 against each other. Thus, the walls 44 of Neri cannot be considered as contacting side tabs 22 and 23 and cannot be considered as “permanently sealing the side tabs”, particularly at the location where the side tabs were previously sealed by the laser beam. (Applicants continue to maintain, as previously presented in Applicants’ Response and Amendment filed 20 March 2006, “compressing means” does not provide the function of sealing or fastening the tabs as the term “sealing” is commonly defined and understood.)

As an alternative basis for rejecting claim 48, and showing the weakness of the rejection, the Advisory Actions refer to a stacking step of Neri and suggest that the stacking step could be considered as a step of permanently sealing side, bottom, and top tabs. More particularly, the Advisory Actions state "the claimed permanently sealing could be considered as of stacking the backs, *somehow* they will be compressing each other by the sides, top, and bottom". (Emphasis added).

That "somehow" something may happen in a device disclosed in a cited reference fails to provide prima facie support for a rejection.

No citation is presented to any text or element number in Neri that teaches the stacking of one pack in relation to another pack after one of the packs has been wrapped in wrapper 34 and the side tabs 22 and 23 and also the bottom and top tabs 24 and 25 sealed by the laser beams, in a manner such that one pack presses against or compresses the side tabs 22 and 23 after they have been sealed by the laser beam or presses against or compresses top and bottom tabs 24 and 25 after they have been sealed by a laser beam. The only stacking of one pack against another pack after they have been wrapped disclosed in Neri is illustrated in Fig. 1, and the only contact between the two packs is between their respective adjacent large flat sides. Neither of the large flat sides includes side tabs 22 and 23 or top and bottom tabs 24 and 25. Thus, the stacking of the packs disclosed in Neri does not in any way provide for a compression by one pack against side tabs 22 and 23 or against top and bottom tabs 24 and 25 of another pack, after the tabs have been sealed by their respective laser beams.

Moreover, even if the above deficiencies in Neri can be set aside, as noted in Applicants' Response and Amendment filed 20 March 2006, and in prior responses submitted by the Applicant, Neri fails to teach or suggest the order of steps recited in Claim 48. Claim 48 recites the side tabs are pre-sealed and then the top and bottom tabs are pre-sealed before either the side tabs or the top and bottom tabs are permanently sealed (note the word "subsequently" in Claim 48). Neither the Final Office Action mailed January 18, 2006 nor the Advisory Actions address this point. There is no showing in any of the Actions where "permanently sealing" side tabs of Neri, namely tabs 22 and 23, occurs after the sealing of the end tabs 24 and 25 by the laser beam. Note that laser beam 53 seals side tabs 22 and 23 together only along a portion, not along the full length, of their overlap, the sealed portion being located between the top and bottom side edges

of the pack. Laser beam 53 does not seal the portion 35 defined as the lateral end portions of folded portions 22 and 23 projecting laterally on either side of product 3 (See Col. 3, lines 36-38).

**CONCLUSION**

Favorable reconsideration and allowance, or the re-opening of prosecution on the merits, of the present application are hereby courteously requested. Should the Examiner have any further questions or reservations, the Examiner is invited to telephone the undersigned Attorney at 770.933.9500 (ext. 213).

Respectfully submitted,



Todd Deveau

Registration No. 29,526

**THOMAS, KAYDEN,**  
**HORSTEMEYER & RISLEY, LLP**  
100 Galleria Parkway, Suite 1750  
Atlanta, Georgia 30339  
Phone: 770-933-9500  
Fax: 770-951-0933